

### REMARKS

Reconsideration of the Application respectfully is requested. For the reasons indicated in detail hereafter, the Application is urged to be in condition for allowance.

A Petition for Extension of Time (one month) with the appropriate fee is being filed concurrently herewith.

It respectfully is pointed out that the continued rejection of the Application under 35 U.S.C. §102(b) over the inadequate teachings of anything published with respect to European Plant Breeders Rights Application No. 97/0101 concerning the 'Meinussian' variety would be inappropriate. There has been a misapplication of the law in the Official Action.

One cannot reproduce the 'Meinussian' variety in view of anything that was published more than one year prior to Applicant's January 28, 1999 effective filing date.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present application. It was there held that in order to be a statutory bar, a printed publication with respect to a new plant variety that is sought to be patented under 35 U.S.C. §§161 to 165 must be adequate in its teachings to enable the reader in combination with scientific knowledge of the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." The two rose varieties under discussion in the *LeGrice* case were available to the public outside

the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210.

This is confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals

Decision where it stated:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination in view of the express language utilized by Congress in 35 U.S.C. §102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.*, Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. Had the availability of plants of the subject *LeGrice* varieties outside the United States been considered to be relevant in its evaluation, it would have been addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re LeGrice* decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to plant variety protection and properly was consistently applied and followed by

Examiners of traditional Plant Patents pursuant to 35 U.S.C. §§161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application was not followed by Examiners of the U.S. Patent and Trademark Office in the past for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. §102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re Le Grice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is today no way that even the most skilled plant scientist could reproduce the claimed 'Meinussian' variety from a reading of anything that was published with respect to this variety more than one year prior to the January 28, 1999 effective filing date. The mere possibility for one to seek a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more

than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Meinussian' variety.


The Examiner has cited no authority for the assertion that the availability of an invention outside the United States combined with a non-enabling publication has ever been used to create a statutory bar other than the *Ex parte Thomson* decision. As specified at 35 U.S.C. §161, Plant Patents and Patents for other inventions should be subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. The recent *Elsner* and *Zary* decisions of the United States Court of Appeals of the Federal Circuit as a matter of constitutional law are incapable of changing the content of Title 35 as enacted by Congress. Accordingly, the rejection is in error and should be promptly withdrawn.

The issuance of a formal Notice of Allowance is urged to be in order and respectfully is requested. Basic fairness to Applicant requires this outcome. If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved at a personal interview.

Respectfully submitted,

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